



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,010	08/25/2000	Nobuyuki Tomihashi	20-4744P	5697

2292 7590 10/24/2002

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
----------	--------------

1713

9

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,010

Applicant(s)

TOMIHASHI ET AL.

Examiner

D. R. Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1713

DETAILED ACTION***Response to Amendment***

1. Applicant's amendment filed 9/19/02, has been fully considered with the following results.
2. The amendment did not fully overcome the rejection under 35 U.S.C. § 112, first paragraph, and the rejection is maintained in part as is discussed below.
3. The amendment overcomes the rejection under 35 U.S.C. § 112, second paragraph and the objection to claims which are withdrawn.
4. The amendment is not deemed to be persuasive in overcoming the prior art rejections which are maintained for the reasons discussed below.

Previously Cited Statutes

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

6. ***Claim 10, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for coated articles wherein the coating composition comprises basic salts of compounds containing at least two phenolic hydroxyl groups as curing agents, does not reasonably provide enablement for coated articles wherein the coating composition comprises fluoroelastomers not containing repeating -CH₂- groups or other basic polyol curing agents.*** The basis of this rejection was stated in Detailed Action § 6 of the previous Office Action. While applicant has amended the claims to recite that the curing agent is a basic salt of a compound having at least two hydroxyl groups, it is not seen that the specification is enabling for curable compositions wherein the curing agent is other than a basic salt of a compound containing at least two phenolic hydroxyl groups. Even in their response applicant states "[t]he present invention uses a basic salt of a compound containing at least two phenolic hydroxyl groups as a curing agent" (underlining added). While salts of other types of hydroxyl compounds are well known, it is not seen that such salts would be useful or effective in an aqueous environment. It is also not seen that applicant has given any guidance as to how to select effective salts other than those containing phenolic hydroxyl groups. Undue experimentation would clearly be necessary to practice the invention beyond the scope of compositions

Art Unit: 1713

containing a basic salt of a compound containing at least two phenolic hydroxyl groups as the curing agent.

Claim Rejections - 35 USC § 102/§ 103

7. ***Claims 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by EP'096.***

The basis of this rejection was stated in Detailed Action § 11-12 of the previous Office Action.

8. Applicant traverses the rejection arguing that “--- EP '096 fails to disclose all the features of the claimed invention ---” and alleging that, “EP '096 merely discloses the polyamine curing agent in the Examples (starting at page 5).” The argument is clearly in error and cannot be sustained. Applicant has ignored the specific teachings referenced in the stated rejection, i.e.,

“Preferable vulcanizing agents (i.e., curing agents) include bisphenol AF and metal salts thereof (page 4, lines 4-6). One of ordinary skill in the art would have readily envisaged using a metal salt of bisphenol AF as the curing agent because it is one of a limited number of preferred curing agents specifically named.”

To the degree that applicant is arguing there is no working example with a metal salt of bisphenol AF, applicant must surely realize a reference is not limited to teachings of the working examples any more than applicant's application is limited to working examples.

9. Further, the Examiner has not admitted that EP'096 does not disclose all features of the present invention under paragraph 15, page 5 of the Office Action as alleged. The admission under the obviousness rejection was only that the elected specie of the sodium salt was not specifically disclosed, i.e.,

“EP'096 discussed above is deficient only in regards to specifically teaching that the metal salt of the bisphenol AF curing agent can be the elected specie of a sodium salt.”

10. ***Claims 10, 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over EP'096 in view of Examiner's Notice.***

The basis of this rejection was stated in Detailed Action § 14-15 of the previous Office Action.

11. Applicant traverses the rejection arguing that the references themselves must state the motivation or suggestion to combine the references, and one having ordinary skill in the art must reasonable expect to be successful in achieving the present invention upon reading the references.” This is not deemed to

Art Unit: 1713

be persuasive because the references do not have to state the motivation or suggestion to combine the references.

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998).

In the instant situation the reference has specifically taught metal salts of bisphenol AF as a preferred curing agent. Clearly one of ordinary skill in the art would look to what metal salts could be readily obtained or made, and/or what metal salts of bisphenol AF had otherwise been used in curing fluororubbers. There would be a reasonable expectation of success because the reference broadly teaches metal salts are effective.

12. Applicant further traverses the rejection on the basis that no references were provided to support the Examiner's Notice.

Things believed to be known to those skilled in the art are often asserted by the examiner to be well known, or matters of common knowledge. If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. *In re Malcolm*, 1942 C.D. 589; 543 O.G. 440. If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. See M.P.E.P. § 2144.03.

13. Even though applicant has not provided any basis to doubt the Examiner's Notice, (*In re Boon*, 58 CCPA 1035, 169 USPQ 231 (1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice), the Examiner provides the following references to support the Notice. Examples teaching and/or making obvious the use of the sodium salt as the metal salt of bisphenol AF taught by EP'096 include Yamamoto (col. 2, line 51 to col. 3, line 8), Sonoji (col. 3, lines 45-62) and Kometani (col. 3, lines 4-23). As to the teaching of alkali metal salts, one of ordinary skill in the art would be aware that this specifically includes sodium salts.

Action Is Final

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1713

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. This application contains Claims 1-9 and 11 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R. Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R. Wilson
Primary Examiner
Art Unit 1713